



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/644,651

08/20/2003

Stephen F. Mase

14491.01

5444

7590

01/21/2009

Devan V. Padmanabhan
DORSEY & WHITNEY LLP
Intellectual Property Department
50 South Sixth Street, Suite 1500
Minneapolis, MN 55402-1498

EXAMINER

GOLDMAN, MICHAEL H

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

01/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/644,651	Applicant(s) MASE ET AL.	
	Examiner MICHAEL H. GOLDMAN	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2008 has been entered.

Response to Amendment

2. The following is a non-final, first action in response to communications received October 27, 2008. Claims 5 and 16-19 have been cancelled. Claims 1 and 11 have been amended. Therefore, claims 1-4 and 6-15 are pending and addressed below.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 and its dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v.*

Art Unit: 3688

Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Also see, United State Court of Appeals for the Federal Circuit, 2007-1130,
(Serial No. 08/833,892)
IN RE BERNARD L. BILSKI
and RAND A. WARSAW.

For example in claim 11, the steps of “evaluating the plurality of offers...”, and “matching a selected offer...”, etc. should individually incorporate a particular machine (computer, apparatus or hardware per se); otherwise it can be concluded, under a broad interpretation, that those steps were manually performed. Here, to be statutory, under USC 101, each individual step should incorporate or should be performed using a particular machine (computer, apparatus or hardware per se).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Schiff et al. (20030158777).

Claim 1 and 11: Schiff et al. discloses the claimed marketing system that matches a customer profile to marketing offers, the marketing system comprising:

a database including customer profile containing information related to a customer's interests in products or services (see page 4 [0077] and Fig 1B discloses client database, portfolio database, RMCS, CRM and Ad Server whereby the databases are linked as a system via the AS, (see [0064]), to produce the equivalent of the database containing all of the elements; also see [0082] for matching function of customer profiles and messages to be sent, examiner construes messages to be offers);

a data base including a plurality of marketing offers related to products and services (see page 1 [0011] lines 5-6 whereby a number of banners, examiner construes as offers, as an example, are shown to the surfer (customer) as desired by

Art Unit: 3688

the surfer; also see [0082] lines 8-9 whereby the system may include a Rich Media Campaign Server which builds the files that hold all the relevant information and sends it to the AS to start the process of showing the relevant message(s)/offer(s) to the relevant surfer/user, examiner construes these messages as a plurality of marketing offers);

a server for executing a program operable to match a selected offer of the plurality of marketing offers to the customer profile, the customer profile being a *permission based marketing profile within the server* which continuously communicates through Internet to scan for product and service offers that appear to match the customer profile and provides customer instant communication with a product and/or service provider and provides customer instant communication with a product and/or service provider (see FIG 1B, Administration Server (AS) and page 11, claim 1.iii, lines 1-3 whereby *messages*, examiner construes as *marketing offers*, are displayed according to user portfolio, also see Paragraph [0001], lines 3-4 whereby [the] ‘...communication system and method...is useful for the direct communications of a services and goods provider with an Internet surfer...’), examiner interprets the system as implicitly continuously communicating through the internet when the user is connected, and also that instant communication is inherent to the internet, also see [0017], lines 1-3 whereby an Administration Server in which user portfolios are stored and [0018], lines 1-4 whereby every registered user generates and updates one or more user portfolios containing information relative to Providers the messages (for products and services) of which the user is willing (permission) to view).

Claim 2: Schiff et al. discloses the invention as in claim 1 above. Schiff et al. further discloses the system wherein the program is operable to present marketing offers to each customer, based on the results of the matching agent (see page 11, claim 1.iii, for displaying offer, lines 1-3 and 2.ii for matching from the database and claim 3.iii for generating one or more messages, examiner construes as marketing offers, and claim 16 wherein a system for messaging over a data messaging makes the invention operable).

Claim 3: Schiff et al. discloses the invention as in claim 1 above. Schiff et al. further discloses the system wherein the marketing offers are located on a plurality of distributed databases, the database in communication through a communication network (see page 3[0064] lines 1-11 whereby the AS, which contains data relative to all the databases including advertising messages, construed by examiner as marketing offers, whereby the AS may physically be one or a plurality of servers/databases, which may be physically located at the same or at different locations on the net; also see claims 3.ii and 3.iv which discloses selecting messages/marketing offers from a database and transferring the message(s) selected to the sent to one or more selected customers via a server, claim 1.i).

Art Unit: 3688

Claim 4: Schiff et al. discloses the invention as in claim 3 above. Schiff et al. further discloses the system wherein the plurality of databases are located on-site at a company originating at least one of the marketing offers (see page 3 [0064] lines 1-5 and 8-10 which discloses the system wherein the plurality of databases (contained in AS) may be physically located at different locations on the net, construed by examiner to include originating company with at least one of the marketing offers).

Claim 6: Schiff et al. discloses the invention as in claim 1 above. Schiff et al. further discloses a system including a client computer in communication with the server via a communication network (see Fig 1A whereby client computer, labeled as "U1" with figure of user computer connected to WWW, the communication network via AS, Administration Server).

Claim 7: Schiff et al. discloses the invention as in claim 6 above. Schiff et al. further discloses the system wherein the client computer includes an applet received from the server (see page 2 [0044] lines 4-7 whereby embedded sources or subroutines, ActiveX control are addressed as one of the preferred embodiments; the ActiveX enables browser is a species of an applet).

Claim 8: Schiff et al. discloses the invention as in claim 7 above. Schiff et al. further discloses the system wherein the applet is configured to prompt the customer using the client computer to enter the customer profile (see page 5 [0089] lines 1-3 and

Art Unit: 3688

whereby FIG 2C is an example of portfolio update/registration via a feature embedded into plug-in the browser, examiner construes as an applet, FIG 2C discloses an example of a *prompt* "Add Company" item 200, which initiates an update to portfolio, in the browser window).

Claim 9: Schiff et al. discloses the invention as in claim 8 above Schiff et al. further discloses wherein the applet is further configured to communicate the customer profile to the server (see FIG 2C and [0089] lines 7-9 whereby the plug-in/applet causes the selection of a profile by users to create a URL of the desired provider to be added and further discloses (see [0093] lines 6-12) that the plug-in is configured to communicate the customer profile to AS when the Provider decides it wishes to communicate via the AS to the user plug-ins).

Claim 10: Schiff et al. discloses the invention as in claim 7 above. Schiff et al. further disclose the system wherein the applet is configured to notify the customer at the client computer upon occurrence of a match to the selected offer (see page 5 [0093] lines 16-17; whereby users store their personal data, construed by examiner as user requesting message/offer, on the plug-ins/applet and see lines 18-19 whereby as soon as the company/providers activate the database of users who have registered, construed by examiner as requesting messages/offers, the AS will contact their plug-ins and transfer requested data/messages/offers to the proper place of the consumers

Art Unit: 3688

details; also see page 6 [0096] whereby as soon as the user activates his account, he will see a list of companies that want to send him messages/offers via the AS).

Claim 12: Schiff et al. discloses the invention as in claim 11 above. Schiff et al. further discloses communicating the selected offer(s) to the customer/user (see page 2 [0019] lines 1-3 displaying to one or more users on their terminal, *messages*, construed by examiner as advertisements/*offers* according to the information contained in their portfolio/profile).

Claim 13: Schiff et al. discloses the invention as in claim 11 above. Schiff et al. further discloses the method wherein the selected offer/message is communicated to a client computer via a computer network (see [0027] lines 1-3 whereby the *terminal*, can be any device with Internet connectivity or with any other digital media connectivity, e.g. a Personal Computer (PC)).

Claim 15: Schiff et al. discloses the invention as in claim 11 above. Schiff et al. further discloses the method wherein customer profile includes an *identification of the customer* and a preference of the customer (see page 5 [0093] lines 1-2 wherein according to an embodiment of the invention, the user can add any URL that he wished to his portfolio/profile, construed by examiner as customer preference; also see [0093] lines 8-13 whereby users who have asked to register with their AS *ID*, construed by examiner as *customer identification*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff et al. (20030158777) in view of Eggleston et al. (6061660).

Claim 14: Schiff et al. discloses the invention as in claim 12 above. Schiff et al. further discloses the feature whereby customer preferences/profiles and matching provider/company messages/offers (see page 1 [0011] lines 5-6 whereby a number of banners, examiner construes as offers, are shown to the surfer (customer) as desired by the surfer).

However, Schiff et al. does not expressly disclose the step of fulfilling the selected offer with its corresponding company.

Eggleston et al. discloses a system and method for incentive programs and award fulfillment over a computer network (see [54] and abstract [57] lines 1-2) and page 6, column 2, lines 32-35 whereby via a host computer connected to the network, a client computer of a consumer connected to the network, a sponsor computer connected to a the network sponsor computer, and lines 44-46, via a *fulfillment* automation application program for *associating* a fulfillment method with an award. Examiner construes award fulfillment the same process necessary to receive, service and track orders via Direct Marketing.

Both Schiff et al. and Eggleston et al disclose a method for corresponding users and providers for goods and/or services for efficient and effective delivery via use of a network. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the Schiff et al. marketing system that matches a customer profile to marketing offers to include an automated fulfillment method as taught by Eggleston et al. in order to expressly complete the marketing transaction.

Response to Arguments

7. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues "Schiff discloses a user-driven system and method 'by which the user is the one who requests messages from specific vendors to be shown to him, which is an aim of the present invention, as opposed to the methods described above in which the system decides what and when to show to him'...Accordingly, Schiff not only does not disclose or teach a permission-based marketing profile...". Examiner respectfully disagrees, since the user has control of the portfolio, the system and method is inherently a permission-based marketing profile (Examiner interprets user-driven as inherently permission-based). Further, Schiff et al. provides the 'means for allowing every registered user to generate and update user portfolios containing information relative to the Providers and the individuals the messages of which the user is willing to receive' (paragraph [0032]), examiner interprets the list of Providers and individuals as **unbounded**, see paragraph [0065] 'Company, **any entity** that can be included in a user's list and which can send advertising material...'. Hence, the Schiff et al. system can search/scan for and select from all available providers for matches to the permission-based marketing profile.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg
January 21, 2009

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688

Application/Control Number: 10/644,651
Art Unit: 3688

Page 14